THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN HORVAT and MARY A. HORVAT

Appeal No. 96-3408
Application No. 08/194,904[1]

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claim 6, which is the only claim pending in this application.[2]

We REVERSE.

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[1] Application for patent filed February 14, 1994.

[2] Finally rejected claim 5 was canceled and replaced with claim 6 by the amendment filed November 17, 1995 (Paper No. 14).

BACKGROUND

The appellants' invention relates to a shirt collar having hidden snaps. A copy of claim 6 is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 is:

Reimer[3]	2,043,061 (Germany)	March 9, 1972

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Reimer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 15, mailed April 12, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 13,

[3] While the examiner referred to this reference as either German patent '061 or GP we will refer to this reference as Reimer, the named inventor. In determining the teachings of Reimer, we will rely on the translation provided by the Patent and Trademark Office. A copy of the translation is attached for the appellants' convenience.

filed November 20, 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claim, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claim 6. Accordingly, we will not sustain the examiner's rejection of claim 6 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the applied prior art teachings would appear to be sufficient for one of ordinary skill in the relevant art having the applied prior art before him to

make the proposed modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the applied prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to modify the relevant teachings of the applied prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we turn to the examiner's rejection of claim 6 under 35 U.S.C. § 103 (answer, pp. 3-4). The examiner found that Reimer

> discloses a shirt/collar in combination with a concealed disc fasteners [sic] underneath each collar end and a corresponding fastener on the shirt portion beneath the collar.

The examiner then found that Reimer

> lacks the "pair" of disc shaped fasteners on each apex portion of the collar, one on the edge and the other half way up the collar concealed on the shirt front.

Next, the examiner determined that

> it would have been obvious to place as many fasteners as needed in order to hold the collar in the desired manner preferred by the wearer. Therefore, it would have been obvious to one of ordinary skill is the art to modify the collar fastening means of GP [Reimer] by adding another disc shaped fastener in order to more firmly hold down the collar along a greater area.

Our review of this rejection leads us to conclude that the examiner has not established a prima facie case of obviousness with respect to claim 6. First, even assuming arguendo, that the examiner's determination of obviousness, set forth above, is correct, the proposed modification of Reimer would not have placed the additional disc shaped snap "about half way up the collar" as required by claim 6. Second, we see no teaching whatsoever that would have suggested placing an additional disc

shaped snap "about half way up the collar" as recited in claim 6. The examiner has not provided any factual basis to establish why this limitation would have been obvious to one skilled in the art. While the addition of another disc shaped snap may have been obvious as stated by the examiner, this by itself is not sufficient, in our opinion, to render obvious the limitation mentioned above. Thus, it appears to us that the examiner has engaged in a hindsight reconstruction of the claimed invention, using the appellants' claim as a template. This, of course, is impermissible.[4] Since all the limitations of claim 6 are not taught or suggested by the applied prior art, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness.[5] Thus, we cannot sustain the examiner's rejection of appealed claim 6 under 35 U.S.C. § 103 as being unpatentable over Reimer.

[4] In re Fine, supra; In re Warner, supra.

[5] Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

CONCLUSION

To summarize, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
NEAL E. ABRAMS Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

Appeal No. 96-3408
Application No. 08/194,904

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APPENDIX

6. In combination with a shirt having a collar, a pair of concealed, disc shaped snaps underneath each collar end and a pair of corresponding, disc shaped fasteners on each side of the shirt portion underneath said collar end, one of each of said pair of concealed, disc shaped snaps being about half way up said collar and the other of said pair of corresponding, disc shaped snaps being on the edge of said collar, concealed in front of the shirt and being in snapping relationship to said disc shaped fasteners.

APPEAL NO. 96-3408 - JUDGE NASE
APPLICATION NO. 08/194,904

APJ NASE

APJ ABRAMS

APJ CALVERT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 08 Oct 97

FINAL TYPED: